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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,291	08/05/2003	Cyrus Pershing Henry	YOUZ 2 00087	7979
27885	7590	06/01/2007	EXAMINER	
FAY SHARPE LLP			TOOMER, CEPHIA D	
1100 SUPERIOR AVENUE, SEVENTH FLOOR			ART UNIT	
CLEVELAND, OH 44114			PAPER NUMBER	
			1714	
			MAIL DATE	
			DELIVERY MODE	
			06/01/2007	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/634,291	Applicant(s) HENRY ET AL.	
	Examiner Cephia D. Toomer	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8, 9, 11, 12, 15-17, 31-39, 45, 53-55 and 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 9, 11, 12, 15-17, 31-39, 45, 53-55 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 14, 2007 has been entered.
2. This Office action is in response to the amendment filed March 14, 2007 in which claims 1 and 45 were amended, claim 56 was canceled and claim 57 was added.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 45 and their dependents are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. It is not readily apparent to the examiner where in the specification the limitation "said additive being free from substituted phenol/epichlorohydrin/amine adducts" may be found. The specification does not appear to support this limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 8, 9, 11, 12, 15-17, 34, 35, 45 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machleder (US 4,134, 846).

Machleder teaches a fuel composition comprising a polyalkylene phenol (see abstract), wherein the phenol is present in the fuel at a concentration of about 100-650 ppm (see col. 1, lines 36-46). The polyalkylene substituent has a molecular weight of about 500-3000 and may be polyisobutylene (see col. 7, lines 23-35). The fuel may be jet fuel and may contain antioxidants and metal deactivators (see col. 9, lines 47-64; col. 10, lines 1-2). Machleder inherently teaches the method of claims 45 and 53-33 because he teaches the same fuel composition used in the same environment.

8. Claims 31, 32, 36-39 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machleder (US 4,134,846) in view of Knapp (US 3,145,176).

Machleder has been discussed above. Machleder fails to teach that the antioxidants of his invention are phosphonates. However, Knapp teaches that C₁-C₁₂ dialkyl phosphonates (dilauryl) are used as antioxidants in hydrocarbon fuels (see col. 2, lines 1-9; col. 4, line 54 through col. 5, lines 1-8).

It would have been obvious to one of ordinary skill in the art to include phosphonates in the fuel composition because Machleder teaches that conventional

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antioxidants may be present in his fuel composition and Knapp teaches that phosphonate antioxidants are used to stabilize fuel compositions such as those of Machleder.

9. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Machleder in view of EP 482 253.

Machleder has been discussed above. Machleder fails to teach the claimed metal deactivator. However, EP teaches this compound in a hydrocarbon fuel composition (see page 2, lines 1-3; page 7, lines 26-36).

It would have been obvious to one of ordinary skill in the art to have selected the claimed metal deactivator because Machleder teaches a conventional metal deactivator may be present in his composition and EP teaches that N,N-disalicylidene 1,2-propanediamine is a conventional metal deactivator that is used in fuel compositions.

10. Applicant's arguments filed have been fully considered but they are not persuasive.

11. Applicant argues that the claims are free of the substituted phenol/epichlorhydrin/amine adduct and therefore distinguish over Machleder.

The examiner respectfully disagrees because it is well settled that the omission of a component and its function from a combination is an obvious expedient if the remaining components perform the same function as before. In re Karlson, 136 USPQ 184; In re Wilson, 153 USPQ 740; In re Marzocchi, 173 USPQ 228.

Applicant argues that Machleder fails to teach a method for inhibiting the oxidation of a jet fuel composition.

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Machleder teaches jet fuel composition comprising the claimed phenolic compound. Therefore, it would be reasonable to expect that if the compound inhibits oxidation in the present invention that it would also inhibit oxidation in Machleder, absent evidence to the contrary.

Applicant argues that Machleder fails to disclose a deposit inhibiting additive.

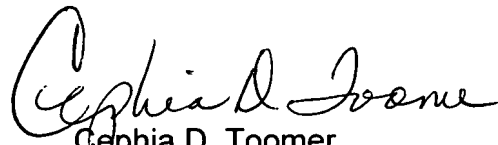
The examiner respectfully disagrees. At col. 7, lines 18-22, Machleder teaches that the polyalkylene phenol component "promotes deposit reduction."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cephia D. Toomer
Primary Examiner
Art Unit 1714

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